

**CUSTOMER NO.: 24498****Serial No. 10/581,815**

Response to First Office Action dated 7/28/08

Response dated: 10/16/08

**PATENT****PD030124****REMARKS**

In the First Office Action, the Examiner noted that claims 1-6, 9, 11 and 12 are pending in the application and that claims 1-6, 9, 11 and 12 stand rejected. By this response, claims 13 and 14 have been added. Claims 1-6, 9 and 11-12 have been amended to more clearly define the invention of the Applicant.

In view of the amendments presented above and the following discussion, the Applicant respectfully submits that none of these claims now pending in the application are anticipated under the provisions of 35 U.S.C. § 102. Furthermore, the Applicant also submits that all of these claims now satisfy the requirements of 35 U.S.C. §101 and 35 U.S.C. §112. Thus, the Applicant respectfully submits that all of these claims are now in allowable form.

**Rejections****A. 35 U.S.C. § 112**

The Examiner rejected claims 1 and 12 under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

The Examiner indicates that claim 1, line 12 recites "being usable for modifying the visibility of at least one other menu item" and that claim 12, line 13 recites "means for modifying the visibility of at least one other menu item to said button command" and that there are insufficient antecedent basis for these limitations in the claims.

In response, the Applicant has herein amended claims 1 and 12 to recite "a visibility" instead of "the visibility". Having done so, the Applicant submits that the basis for the Examiner's rejection of the Applicant's claims 1 and 12 has been removed and as such respectfully requests that the Examiner's rejection of claims 1 and 12 under 35 U.S.C. 112 be withdrawn.

**B. 35 U.S.C. § 101**

The Examiner rejected the Applicant's claims 1-6, 9 and 11-12 under 35 U.S.C. 101 as being directed to non-statutory subject matter.

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The Applicant has herein amended claim 1 to include language to claim 1 which imparts the performing of a function that can be processed by a computer. More specifically, the Applicant's amended claim 1 specifically recites:

- A method for generating an interactive electronic menu on a display, the menu comprising menu buttons, wherein a menu button may be in a deselected, selected or activated state, and the menu being coded into a menu data segment, comprising:
- retrieving a data segment having encoded therein at least data for a first and a second menu button and data connecting the first and the second menu button by a parent-child relationship, wherein the second menu button being a child of the first menu button can only be selected when the first menu button is selected, and wherein at least one button command is associated to the first menu button and coded into said menu data segment, the button command being usable for modifying the visibility of at least the second menu button;
  - generating the interactive menu on a display, wherein at least the first menu button but not the second menu button is displayed; and
  - upon selection of the first menu button and execution of said button command, modifying said interactive menu such that the first and the second menu button are displayed simultaneously.

As clearly depicted in the Applicant's claim 1 as presented above, in the embodiment of the Applicant's invention of claim 1, the method for generating an interactive electronic menu on a display of the Applicant's invention includes a first and second button hierarchy such that a second menu button is only displayed on an interactive menu upon selection of the first menu button and execution of the button command.

As such and for at least the reasons recited above, the Applicant respectfully submits that the Applicant's independent claims 1 and 12 and, as such, dependent claims 1-6, 9 and 11 and new claims 13 and 14 now produce a tangible result and as such are patentable under the provisions of 35 U.S.C. § 101.

#### **C. 35 U.S.C. §102**

The Examiner rejected the Applicant's claims 1-6, 9, 11 and 12 under 35 U.S.C. § 102(b) as being anticipated by Gordon et al. (2002/0013944). The rejection is respectfully traversed.

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The Examiner alleges that regarding claim 1, Gordon discloses a method for generating an interactive electronic menu on a display including all of the aspects of the Applicant's invention and claims. The Applicant respectfully disagrees.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1983)). (emphasis added). The Applicant submits that Gordon fails to disclose each and every element of the Applicant's claimed invention arranged as in at least the Applicant's amended claim 1.

The Applicant submits that in contrast to the invention of the Applicant, Gordon discloses a method and an apparatus for providing subscription-on-demand (SOD) services. In Gordon, a user can select a program package using a GUI menu, thus being able to become a subscriber. If the user is already a subscriber to some program package, the GUI menu shows also options to which the current subscription is not valid, so that the user can also subscribe to these additional options. Gordon teaches that the program and the menu are generated and provided by a remote server. In Gordon, the menu has a plurality of pages that are rendered and displayed one at a time. When a menu selection is made, the system downloads an applet corresponding to the selection, and either launches based on that applet a new menu that provides further options for the subscriber, or displays a selected program such as a movie.

More specifically, in Fig.5, Gordon shows a category display, showing a list of selectable categories. Upon the user selecting a category, the terminal sends a category request and the video session manager sends an applet for a title menu to the terminal. The terminal decodes and executes the applet to display the title menu, depicted in Fig.6. (see 0048). The Examiner alleges that Gordon shows in Figure 5 and Figure 6, first and second menu items. If the first menu item corresponds to the button "Sesame Street" (not shown in Fig.5 but apparently selected in Fig.6), then the second menu item is the title menu of Fig.6.

However, the Applicant submits that in contrast to the invention of the Applicant, what is depicted in Fig. 5 and Fig. 6 of Gordon is a complete menu, and not a "menu button" as taught and claimed by the Applicant. Therefore the Applicant

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submits that Figures 5 and 6 of Gordon only show a classical hierarchical menu and not the menu taught and claimed by the Applicant in at least the Applicant's claim 1.

That is, the Applicant submits that the category menu shown in Figure 5 of Gordon is generated based on an applet, and the title menu of Figure 6 of Gordon is generated based on a different applet. Each applet can be used separately and therefore must be regarded as a separate data segment. Thus, Gordon does not show first and second menu items being coded into a single menu data segment, as taught in the Applicant's Specification and claimed by at least the Applicant's claim 1.

Furthermore, the Applicant submits that even if Gordon shows a parent-child relationship between menus, Gordon does not show such relationship between different menu items of a menu, as taught in the Specification and claimed by at least the Applicant's claim 1. That is, the Applicant's independent claims have been amended to clarify that both menu items are shown simultaneously, as depicted in the Applicant's Figure 1.

In contrast to the invention of the Applicant, Gordon explicitly mentions in paragraph [0038] that "Each command menu is implemented by executing an applet", and in paragraph [0043] that "Whenever a menu selection is made, the system downloads an applet corresponding to that section and either launches a new menu that provides further options for the subscriber or displays a selected program (e.g., starts playing a movie)". In other words, whenever a menu selection is made, then either a new menu screen is rendered, or the menu is finished because the playback of a movie starts. The new menu of Gordon must be downloaded from the service provider, which takes some time. In contrast to the teachings of Gordon, the Applicant teaches and claims that only the second menu button being a child of the first menu button is rendered, while the remainder of the screen is not changed. This has the advantage to reduce the response time for interactive systems (see Applicant's Specification, page 2, lines 28-29, page 3, lines 4-12, and page 7, lines 5-7).

The Applicant respectfully submits that there is absolutely no teaching or suggestion in Gordon for "the second menu button being a child of the first menu button can only be selected when the first menu button is selected, and wherein at least one button command is associated to the first menu button and coded into said menu data segment, the button command being usable for modifying the

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**visibility of at least the second menu button**" and "upon selection of the first menu button and execution of said button command, modifying said interactive menu such that the first and the second menu button are displayed simultaneously". In contrast to the invention of the Applicant, Gordon instead teaches, for example in Figure 5 and Figure 6, a classical hierarchical menu and a lower level menu which may be regarded as a child of the higher level, but only one is shown at a time and not simultaneously. In addition a first and second menu button are not taught in Gordon, instead two complete menus or menu pages are taught.

In addition, the Applicant further submits that in contrast to the invention of the Applicant, Gordon instead teaches, that menus of Fig.5 and Fig.6 are coded in separate applets and not **"coded into said menu data segment, the button command being usable for modifying the visibility of at least the second menu button"** as taught and claimed by the Applicant. In addition, in contrast to the invention of the Applicant, Gordon teaches that a visibility of menu is modified, but not of menu **button** as taught and claimed by the Applicant.

Therefore and for at least the reasons recited above, the Applicant submits that Gordon fails to disclose each and every element of the Applicant's claimed invention as claimed in at least the Applicant's claim 1.

In addition, in contrast to the Applicant's Claim 2, Gordon shows second menu, but not 1<sup>st</sup> and 2<sup>nd</sup> menu items. Further, the first menu button of Fig.5 must have been in the "activated" state, not in the "selected" state as claimed, since otherwise the menu of Fig.6 would not be visible.

In addition, in contrast to the Applicant's Claim 3, it is unclear what the "second menu item" is in Gordon and in Fig.5 and Fig.6 seemingly everything is selectable.

In addition, in contrast to the Applicant's Claim 4, neighbor information is not disclosed by Gordon. Though direction vectors of the joy stick are interpreted by the CPU to highlight a region lying in the direction in which the joy stick was moved (see 0036), the neighbor relationship is based on display position (this is conventional). Thus, the code segment will not include information about neighbor buttons. Gordon does not explicitly disclose the contents of the code segment. Claim 4 calls for neighbor information being encoded within the menu data segment. This difference has the following effect: With the neighbor information, relationship is independent

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from actual display position, so that ambiguous cases can be handled (e.g. if buttons are not exactly in a line, which is used for achieving a certain aesthetic effect).

In addition, in contrast to the Applicant's Claim 5, Gordon's system requires video session manager 122 at the service provider equipment 102 (see 0026 on page 3 and Fig.1) for interpretation of certain menu commands (see 0039, 0043 and 0049), therefore the menu data segments can not be stored on read-only medium that is exchangeable at the users side.

In addition, in contrast to the Applicant's Claim 6, a color-LUT is not the same as highlighting (highlighting does not modify the color-LUT).

In addition, in contrast to the Applicant's Claim 9, the menu items of Gordon are in different segments.

In addition, in contrast to the Applicant's Claim 11, Gordon does not teach an identifier within the menu, but within the terminal; this identifier is not suitable for indicating parent-child relationship.

Therefore and for at least the reasons recited above, the Applicant submits that Gordon fails to disclose each and every element of the Applicant's claimed invention as claimed in at least the Applicant's independent claims 1 and 12.

Therefore, the Applicant submits that for at least the reasons recited above, the Applicant's claim 1 is not anticipated by the teachings of Gordon, and, as such, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

Likewise, the Applicant's independent claim 12 recites and claims similar relevant features as claimed in the Applicant's claim 1. As such, the Applicant submits that claim 12 is also not anticipated by the teachings of Gordon, and, as such, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

Furthermore, the Applicant's dependent claims 2-6, 9 and 11 and new claims 13-14 depend either directly or indirectly from the Applicant's independent claims 1 and 12 and recite additional features thereof. As such, the Applicant submits that at least because the Applicant's claims 1 and 12 are not anticipated by the teachings of Gordon, the Applicant further submits that the Applicant's dependent claims 2-6, 9 and 11 and new claims 13-14, which depend either directly or indirectly from the Applicant's claims 1 and 12, are also not anticipated by the teachings of Gordon,

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and, as such, fully satisfy the requirements of 35 U.S.C. § 102 and are patentable thereunder.

The Applicant reserves the right to establish the patentability of each of the claims individually in subsequent prosecution.

### Conclusion

Thus, the Applicant submits that none of the claims, presently in the application, are anticipated under the provisions of 35 U.S.C. § 102. Furthermore, the Applicant also submits that all of these claims now satisfy the requirements of 35 U.S.C. §101 and 35 U.S.C. §112. Consequently, the Applicant believes that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion, it is respectfully requested that the Examiner telephone the undersigned.

No fee is believed due. However, if a fee is due, please charge the additional fee to Deposit Account No. 07-0832.

Respectfully submitted,

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